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John Phillips

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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3685

MAIL DATE

DELIVERY MODE

07/09/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/716,197	<b>Applicant(s)</b> PHILLIPS ET AL.	
	<b>Examiner</b> JOHN M. WINTER	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 49-87 is/are pending in the application.
- 4a) Of the above claim(s) 54,61-63 and 65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-53,55-60,64 and 66-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

The Applicants amendment filed on May 3, 2008 is hereby acknowledged, Claims 49-53, 55-60, 64, and 66-87 remain pending .

### ***Response to Arguments***

The Applicant states that the claims of the present invention are directed towards a different purpose and are not obvious in view of the prior art.

Examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) “To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.”, the Examiner states the reference deals with the generalized problem of electronic content distribution therefore would be obvious to a person of ordinary skill in the art.

Applicant challenges the Examiner's Official Notice on page 5 of the Office Action. It is considered that the quoted section of the claim is not common knowledge and well known in the prior art and the examiner is required to cite support for such assertion.

The Examiner responds that element 1512 of figure 15 of US Patent 7,225,160 (Stefik et al.) discloses the feature of allowing usage unit an expiration date is met; further element 1510 discloses increasing a copy count.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 49-53, 55-60, 64, and 66-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akiyama et al (US Patent 5,805,699) over Cooper et al. (US Patent 5,563,946)

As per claim 49

Akiyama et al. discloses a method for sharing data with one or more recipients, the method comprising:

creating and storing a bundle containing information about the selection of data in a location accessible by a bundle server; associating bundle identification information with the bundle; creating a token representing the bundle, the token including the bundle identification information; (Column 3, lines 41-50)

providing the token to a recipient; establishing communication between the recipient and the bundle server: receiving a request for the bundle from the recipient, the request comprising, at least in part, the bundle identification information from the token; and providing a copy of the bundle to the recipient having the token; (Column 4, lines 4-24)

Akiyama et al. does not explicitly disclose identifying a selection of data to be shared. Cooper et al. discloses identifying a selection of data to be shared (Figure 8) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Akiyama et al.'s method with Cooper et al.'s teaching in order to allow related software products to be purchased and licensed together

Akiyama does not specifically disclose "wherein the bundle identification information comprises: a bundle identifier comprising a value generated randomly within a range of one million or more possible values; a bundle store identifier comprising a value generated randomly within a range of one million or more possible values; and an encrypted bundle name, corresponding to a bundle name associated with the bundle, the encrypted bundle name generated using the bundle store private key"

Official Notice is taken that "a bundle identifier comprising a value generated randomly within a range of one million or more possible values; a bundle store identifier comprising a value generated randomly within a range of one million or more possible values; and an encrypted bundle name, corresponding to a bundle name associated with the bundle, the encrypted bundle name generated using the bundle store private key" is common and well known in prior art in reference to electronic transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to randomly name an identifier in order to prevent predictive spoofing of the transaction system.

Claims 52, 53,55, 57-58 ,60-64, 66 and 43 are not patentably distinct from claim 49 and are rejected for at least the same reasons.

As per claim 50

Akiyama et al. discloses a method according to claim 49,  
wherein creating the bundle comprises storing the bundle in a bundle store, the bundle store associated with a bundle store sharer identity, the bundle store sharer identity being unique among a plurality of bundle store sharer identities corresponding to a plurality of bundle stores accessible to the bundle server, the bundle store containing one or more bundles, corresponding to a sharer, the sharer having a sharer identity, matching the bundle store sharer identity (Column 4, lines 4-23).

As per claim 51,

Akiyama et al. discloses a method according to claim 50,  
wherein the bundle store is associated with a bundle store key pair generated by an asymmetric encryption system, the key pair including a bundle store public key and a bundle store private key and wherein creating the token comprises including the bundle store public key in the token (Figure 6).

As per claim 56,

Akiyama et al. discloses a method according to claim 69,  
Akiyama does not specifically disclose “incrementing the retrieval count each time a copy of the bundle is provided to a recipient”

Official Notice is taken that “incrementing the retrieval count each time a copy of the

bundle is provided to a recipient” is common and well known in prior art in reference to electronic transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to increment a copy count in order to ensure that a users license count has not been exceeded.

As per claim 59,

Akiyama et al. discloses a method according to claim 69,

Akiyama does not specifically disclose “obtaining a current date, and, communicating with the bundle server only if the expiry date is later than the current date”

Official Notice is taken that “obtaining a current date, and, communicating with the bundle server only if the expiry date is later than the current date” is common and well known in prior art in reference to electronic transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a date in order to ensure that the client has a valid license.

As per claim 67,

Akiyama et al. discloses a method according to claim 66,

comprising delivering said bundle when said testing determines that said communication includes said bundler identifier(Column 3, lines 41-65).

As per claim 68,

Akiyama et al. discloses a method according to claim 67,

wherein said receiving is from said recipient computer system and said delivering is to said recipient computer system (Figure 4) .

As per claim 69,

Akiyama et al. discloses a method according to claim 68,

wherein said bundle server comprises another computer system separate from said sharer computer system and said recipient computer system, said bundle server includes said bundle store, and said creating further comprises sending said files and/or folders to said bundle Server (Figure 4).

As per claim 70,

Akiyama et al. discloses a method according to claim 69,

Akiyama does not specifically disclose “providing said token as an attachment to an e-mail communication”

Official Notice is taken that “providing said token as an attachment to an e-mail communication” is common and well known in prior art in reference to electronic transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize email to send a token because this is an inexpensive and reliable manner to deliver information.

As per claim 71,

Akiyama et al. discloses a method according to claim 66,



wherein said bundle server comprises another computer system separate from said sharer computer system and said recipient computer system, said bundle server includes said bundle store, and said creating further comprises sending said files and/or folders to said bundle server (Figure 4).

As per claim 72,  
Akiyama et al. discloses a method according to claim 66,  
further comprising maintaining a record of contents of said delivered bundle (Column 3, lines 41-65).

As per claim 73,  
Akiyama et al. discloses a method according to claim 66,  
further comprising maintaining a copy of said bundle following said delivering (Column 3, lines 41-65).

As per claim 74,  
Akiyama et al. discloses a method according to claim 66,  
wherein said generating further comprises deriving contextual information about said selection of files and adding said contextual information to said token (Column 4, lines 25-42).

As per claim 75,  
Akiyama et al. discloses a method according to claim 74

wherein said contextual information includes a digest of said bundle (Column 4, lines 25-42).

As per claim 76,

Akiyama et al. discloses a method according to claim 69,

Akiyama does not specifically disclose “following said generating of said token and prior to said sending of said token, allowing the sharer to alter said bundle in said bundle store”

Official Notice is taken that “following said generating of said token and prior to said sending of said token, allowing the sharer to alter said bundle in said bundle store” is common and well known in prior art in reference to electronic transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to alter a bundle prior to shipping in order to allow a consumer to change or update an order.

As per claim 77,

Akiyama et al. discloses a method according to claim 66

further comprising sending said token to a plurality of additional recipient computer systems, repeating said receiving, testing, and delivering at least once (Column 4, lines 4-23).

As per claims 78-82

Akiyama et al. discloses a method according to claim 66

Official Notice is taken that “maintaining a ratio of a number of the possible values to a number of bundles in the bundle store to be at least  $10^{20} : 1$ ” etc... is common and well known

in prior art in reference to databases. It would have been obvious to one having ordinary skill in the art at the time the invention was made that a value would have a high ratio of values v/s possible values in order to populate a database without danger of key duplication. A database that use a license number 20 or 15 digits in length as a key would easily maintain this ratio, also a large license would be nearly impossible to “guess” (i.e. brute force crack) and ould therefore meet the limitations of claim 12 as well

As per claim 83,

Akiyama et al. discloses a method according to claim 66

wherein said bundle store is associated with a bundle store key pair generated by an asymmetric encryption system, said key pair including a bundle store public key and a bundle store private key, and wherein said generating further comprises including said bundle store public key in said token (Figure 6).

As per claim 84,

Akiyama et al. discloses a method according to claim 83

receiving one or more communications at said bundle server, said communications encrypted with said bundle store public key; and  
sending one or more other communications from the bundle server, said communications encrypted with said bundle store private key (Figure 6).

As per claim 85,

Akiyama et al. discloses a method according to claim 83

wherein said token includes an encrypted bundle name, corresponding to a bundle name associated with the bundle, the encrypted bundle name generated using the bundle store private key (Figure 6).

As per claim 86,

Akiyama et al. discloses a method according to claim 66 further comprising:  
receiving a pass-phrase from a user of said sharer computer  
system: and prior to said sending, encrypting said token wherein said token can be decrypted  
with use of said pass-phrase (Figure 6).

As per claim 87,

Akiyama et al. discloses a method according to claim 66 further comprising:  
creating a bundle key; encrypting at least a part of said bundle using said bundle key; and, storing  
said bundle key in said token (Figure 6).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Winter

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Examiner 3685

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685